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EXPEDITED EXAMINING PROCEDURE  
ART UNIT: 1616

PATENT  
09/425-083

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IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: HAYASHI et al. Conf.: 7584  
Appl. No.: 09/842,896 Group: 1616  
Filed: April 27, 2001 Examiner: A. PRYOR  
For: PLANT-ACTIVATING AGENT

PETITION FROM REFUSAL TO ADMIT  
AMENDMENT UNDER 37 C.F.R. § 1.127

**BOX AF**

Assistant Commissioner for Patents  
Washington, DC 20231

November 26, 2002

Sir:

Responsive to the Advisory Action dated March 9, 2001 which issued in connection with the above-identified application, this is a Petition under 37 C.F.R. 1.127 and 1.181 requesting entry and consideration of the amendments submitted in the Response filed September 30, 2002 after the Final Office Action. For the following reasons, it is submitted that this Petition is proper and that the Response filed September 30, 2002 should be entered of record and fully considered since this Response complied with the requirements of 37 C.F.R. §1.116.

### History of Events

On January 28, 2002, the Examiner mailed an Office Action wherein the Examiner cited Eibner et al. (GB 2116960) against the claimed plant activating agent.

Eibner et al. teach a plant promoting preparation having a controlled release rate of the nutrients wherein the plant promoting preparation has a plant promoting agent which is in a fertilizer which can possibly be enveloped with an enveloping agent, wherein the enveloping agent includes, among a laundry list of possibilities, metal soaps.

In Applicants' Amendment filed April 29, 2002, Applicants argued for the patentability of the inventive plant promoting agent, since Eibner et al. do not teach or fairly suggest metal soaps as the enveloping agent.

In response, the Examiner issued a final Office Action on June 28, 2002 and maintained the rejection of the present claims over Eibner et al.

In response, in order to remove the rejection over Eibner et al., Applicants filed an Amendment under 37 CFR 1.116 on September 30, 2002, wherein the claims were amended to delete the recitation that the plant activating agent could be a metal soap. In other words, the claims were amended to remove the possibility that  $X^1$  is a counter ion in the plant activating agent of formula (II). The claims were amended as follows:

**4. (Twice Amended)** The method as claimed in claim 8, which is the compound (2) represented by the formula (II) wherein n is zero to 20; R represents an alkyl or alkenyl group having 13 to 21 carbon atoms,  $X^1$  represents a hydrogen atom, an alkyl or acyl group having 1 to 22 carbon atoms[, or an alkenyl group having 2 to 22 carbon atoms[, or a counter ion (when n is not zero, the counter ion is excluded)].

**8. (Twice Amended)** A method of activating a plant by applying a plant-activating agent to the plant, said plant-activating agent is capable of promoting growth of the plant by itself and is a compound of formula (II),



wherein R represents an alkyl or alkenyl group having 11 to 29 carbon atoms;  $X^1$  represents a hydrogen atom, an alkyl or acyl group having 1 to 30 carbon atoms[, or an alkenyl group having 2 to 30 carbon atoms[, or a counter ion]; AO represents at least one group selected from oxyethylene, oxypropylene and oxybutylene groups and may be random or block; and n represents an average number of moles added and is zero to 30.

**10. (Amended)** A plant-activating composition comprising a plant-activating agent and a fertilizer agent, said plant-activating agent is a compound of formula (II),



wherein R represents an alkyl or alkenyl group having 11 to 29 carbon atoms;  $\text{X}^1$  represents a hydrogen atom, an alkyl or acyl group having 1 to 30 carbon atoms[, or an alkenyl group having 2 to 30 carbon atoms[, or a counter ion]; AO represents at least one group selected from oxyethylene, oxypropylene and oxybutylene groups and may be random or block; and n represents an average number of moles added and is zero to 30[; wherein when n is zero and  $\text{X}^1$  is a counter ion, then R has an even number of carbon atoms].

In response, the Examiner issued an Advisory Action (dated November 4, 2002) wherein the Examiner indicated that he would not enter Applicants' September 30, 2002 Amendment, since the September 30, 2002 Amendment "requires further consideration and/or search".

Applicants respectfully disagree with the Examiner. Since the September 30, 2002 Amendment served to further limit the scope of the claims, the Examiner would not be required to engage in a further search. Also, the amount of consideration required to see that the presently claimed invention is not made obvious by Eibner et al. would be minimal.

Based on the Examiner's comments in the paragraph numbered as 5 on page 2 of the January 28, 2002 Office Action, the Examiner makes it clear that Eibner et al. is cited for teaching metal soaps such as a salt of a stearic acid.

**October 29, 2002 Telephone Conversation**

During a telephone conversation between Examiner Pryor and Applicants' representative on October 29, 2002, Examiner Pryor offered to allow the present application if the specification and claims were amended as indicated in the attached Appendix (hereinafter Examiner's Proposed Amendment).

The Examiner indicated that he did not have any specific art in hand, but that he **knew** there to be in existence references which teach or fairly suggest the present invention as stated in the September 30, 2002 Amendment. The Examiner was willing to take the chance that the Examiner's Proposed Amendment adequately distinguished the present invention from the references known by the Examiner to be in existence. However, Applicants were not willing to take this chance and requested that the Examiner cite these references in a nonfinal Office Action.

Unfortunately, the Examiner mailed the November 4, 2002 Advisory Action instead of the nonfinal Office Action.

Applicants are concerned that if a Continuation Application is filed at this time in order to force the Examiner to enter the September 30, 2002 Amendment, that the Examiner will again conduct a limited search and stop the search upon finding a reference which teaches a single species of the claimed genus. Clearly, Applicants' concerns are valid.

### **Remedy Sought**

In view of the foregoing, Applicants respectfully request: 1) that the September 30, 2002 Amendment be entered into the Official Record; and 2) the Examiner issues either a Notice of Allowance in the event that no further art is found to be material or a nonfinal Office Action in the event that material art is found.

### **Conclusion**

Should there be any questions, please feel free to contact Garth M. Dahlen, Ph.D. (Reg. No. 43,575) at the telephone number of the undersigned below.

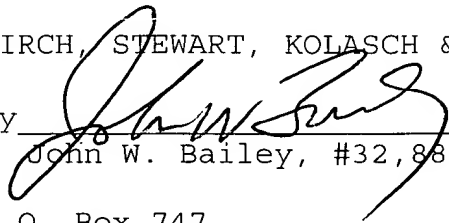
It is Applicants understanding that no fee is required for this petition; however, if necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge

payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


Respectfully submitted,

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Attachment: Proposed Claim Amendments by Examiner during October 29, 2002 Telephone Conversation.

Appendix

IN THE SPECIFICATION:

Page 16,

Line 24, replace "Examples of nonionic surfactants include" with --The nonionic surfactants are--.

Page 17,

Line 11, replace "Examples of anionic surfactants include" with --The anionic surfactants are--.

Page 18,

Line 15, replace "Examples of amphoteric surfactants include" with --The amphoteric surfactants are--.

Page 19,

Line 24, replace "Examples of such inorganic compounds include" with --The inorganic compounds are--.

Page 20,

Lines 6-7, replace "Examples of the organic compounds include" with --The organic compounds are--; and

Line 24, replace "such as" with --which are--.

Page 21,

Line 2, replace "Specific examples thereof include" with --The chelating agents are--; and

Line 11, replace "includes" with --are--.

IN THE CLAIMS:

6. (Twice Amended) A plant-activating composition [comprising] consisting essentially of a plant-activating agent and at least one of a surfactant and a chelating agent and optionally nutrients selected from vitamins, saccharides and amino acids, said plant-activating agent is a compound of formula (II),





wherein R represents an alkyl or alkenyl group having 11 to 29 carbon atoms;  $\text{X}^1$  represents a hydrogen atom, an alkyl or acyl group having 1 to 30 carbon atoms, an alkenyl group having 2 to 30 carbon atoms, or a counter ion; AO represents at least one group selected from oxyethylene, oxypropylene and oxybutylene groups and may be random or block; and n represents an average number of moles added and is zero to 30.

10. (Twice Amended) A plant-activating composition [comprising] consisting essentially of a plant-activating agent and a fertilizer agent and optionally nutrients selected from vitamins, saccharides and amino acids, said plant-activating agent is a compound of formula (II),



wherein R represents an alkyl or alkenyl group having 11 to 29 carbon atoms;  $\text{X}^1$  represents a hydrogen atom, an alkyl or acyl group having 1 to 30 carbon atoms or an alkenyl group having 2 to 30 carbon atoms; AO represents at least one group selected from oxyethylene, oxypropylene and oxybutylene groups and may be random or block; and n represents an average number of moles added and is zero to 30.

15. (Amended) The composition as claimed in claim 6, wherein the composition [comprising] consists essentially of 10 to 20,000 parts by weight of the surfactant and zero to 10,000 parts by weight of the chelating agent per 100 parts by weight of the activating agent.

16. (Amended) The composition as claimed in claim 10, wherein said composition [comprising] consists essentially of 10 to 5,000 parts by weight of the fertilizer component per 100 parts by weight of the activating agent.

17. (Amended) The composition as claimed in claim 15, wherein the [composition further comprises] nutrients are present in 10 to 5,000 parts by weight [of other nutrients] per 100 parts by weight of the activating agent.

18. (Amended) The composition as claimed in claim 16, wherein said [composition further comprises] nutrients are present in 10 to 5,000 parts by weight [of other nutrients] per 100 parts by weight of the activating agent.